

Serial No.: 09/662,601

REMARKS

Claims 1-11 are pending in the application. Claims 2, 3, 6 and 10 are amended herein. Favorable reconsideration of the application, as amended, is respectfully requested.

I. CLAIM AMENDMENTS

The Examiner has identified claims 2, 6 and 10 as representing allowable subject matter. Applicants have amended claims 2, 6 and 10 herein so as to be in independent form. Thus, claims 2, 6 and 10 should now be in condition for allowance.

Applicants have amended claim 3 to independent form and to include the features of dependent claim 11.

Accordingly, the above amendments do not raise any new issues of patentability. Applicants respectfully request entry of the amendments and reconsideration in view of the following comments.

II. REJECTION OF CLAIMS 1-11 UNDER 35 USC §112, 2ND ¶

The Examiner continues to reject claims 1-11 under 35 U.S.C. §112, second paragraph, as being indefinite. Applicants respectfully traverse the rejection for at least the following reasons.

The Examiner continues to argue that the term "other modes" is vague and indefinite. The Examiner notes that other than a fax mode there are no other modes specifically set forth in the claim. The Examiner asks whether applicants could be referring to other modes than that described in the specification?

Applicants respectfully submit that the Examiner is improperly engaging in claim construction during prosecution. Applicants have amended claim 1 to recite specifically that the "other modes" are modes "involving recording image information on a recording medium". The specification clearly provides support for other modes which involve recording image information on a recording medium (e.g., printer mode and copier mode). The U.S. patent laws do not require that applicants recite in the claim itself each and every manner for carrying out the invention. Rather, the patent laws simply

Serial No.: 09/662,601

require that the applicants describe in the specification at least one manner for carrying out the invention.

Further, the patent laws do not require applicants to limit their claim language to the specific embodiments described in the application. Thus, applicants respectfully submit that the Examiner has not provided any reason why applicants should be precluded from claiming "other modes" as broadly as that which is described in the specification. To what extent the claim will be interpreted as covering other modes beyond those specifically described in the application (e.g., printer mode and copier mode), it is difficult to say as one cannot predict at this time what may be viewed as equivalents, etc.

For at least the above reasons, withdrawal of the rejection is respectfully requested.

III. REJECTION OF CLAIM 11 UNDER 35 USC §112, 1ST ¶

The Examiner rejects claim 11 under 35 U.S.C. §112, first paragraph, as failing to comply with the enablement requirement. Applicants respectfully traverse this rejection for at least the following reasons.

Specifically, the Examiner contends that neither the written specification nor the drawings provide support for the complex image processing apparatus being a stand-alone apparatus. Applicants respectfully submit that Fig. 2 of the present application is clear evidence of support for a "stand-alone" apparatus. Fig. 2 clearly illustrates the complex image processing apparatus 30 as a stand-alone device. A person having ordinary skill in the art would readily recognize the complex image processing apparatus 30 as a stand-alone device.

Accordingly, applicants respectfully request withdrawal of the rejection.

IV. REJECTION OF CLAIMS 1, 3, 5, 7-9 AND 11 UNDER 35 USC §102(b)

Claims 1, 3, 5, 7-9 and 11 remain rejected under 35 USC §102(b) based on *Kato et al.* Applicants again respectfully traverse the rejection for at least the following additional reasons.

Serial No.: 09/662,601

Beginning on page 6 of the Office Action, the Examiner responds to the applicants' arguments set forth in their previous response. Notably, the Examiner does not rely on the teachings at column 10, lines 6-21 of *Kato et al.* as before when responding to the applicants' arguments. Rather, the Examiner now relies on column 7, lines 1-18 of *Kato et al.*

Specifically, the Examiner now argues that the facsimile machine 1 in *Kato et al.* initially stores the image data in the image memory 19. Thereafter, the Examiner argues that the facsimile machine 1 sends the image data stored in the image memory 19 to the printer 18 for printing on a page basis.

Initially, applicants point out that *Kato et al.* does not disclose that the printer engine 18 even includes a memory. Thus, it has not been shown in *Kato et al.* that there is a transfer of the image data stored in the memory 19 to a memory for an other mode as recited in claim 1. *Kato et al.* does not teach or suggest a memory in the printer engine 18.

Furthermore, the printer engine 18 in *Kato et al.* is provided only for facsimile reproduction. Therefore, to the extent the printer engine 18 may include a memory such as a buffer, such memory still does not represent a memory for an other mode as recited in claim 1.

Further still, based on the Examiner's reliance on column 7, lines 1-18 of *Kato et al.*, the Examiner may be referring to the buffer memory 12 as representing the memory for facsimile available only in the facsimile mode, and the image memory 19 as representing the claimed memory for the other modes. Even in this case, however, although the buffer 12 may be a memory for facsimile available only in the facsimile mode since unit 1 is only a facsimile, the memory 19 in such case still would not represent a memory for an other mode as recited in claim 1.

Accordingly, the Examiner still has not shown that *Kato et al.* teaches or suggests each and every feature recited in claim 1.

Regarding claim 3, now in independent form, the Examiner rejects the claim based on *Kato et al.* teaching that when the residual storage capacity of the fax memory is determined to be below the predetermined level, data is sent to the PC side

Serial No.: 09/662,601

(see, e.g., Col. 10, Ins. 6-21). However, the data transfer to the external PC which is carried out in *Kato et al.* is different from the data transfer which is carried out between the memories in a stand-alone type apparatus as recited in claim 3.

Furthermore, claim 3 includes all of the features of claim 1. Consequently, claim 3 may be distinguished over *Kato et al.* based on the same reasons discussed above in relation to claim 1.

For at least the above reasons, withdrawal of the rejection of claims 1, 3 and the claims dependent therefrom is respectfully requested.

V. CONCLUSION

Accordingly, all claims are believed to be allowable and the application is believed to be in condition for allowance. A prompt action to such end is earnestly solicited.

Should the Examiner feel that a telephone interview would be helpful to facilitate favorable prosecution of the above-identified application, the Examiner is invited to contact the undersigned at the telephone number provided below.

Serial No.: 09/662,601

Should a petition for an extension of time be necessary for the timely reply to the outstanding Office Action (or if such a petition has been made and an additional extension is necessary), petition is hereby made and the Commissioner is authorized to charge any fees (including additional claim fees) to Deposit Account No. 18-0988.

Respectfully submitted,

RENNER, OTTO, BOISSELLE & SKLAR, LLP


Mark D. Saralino
Registration No. 34,243

DATE: March 28, 2005

The Keith Building
1621 Euclid Avenue
Nineteenth Floor
Cleveland, Ohio 44115
(216) 621-1113
B:\GEN\SAIK\salkp113.aaf.wpd